

No. 12323

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

---

EARL A. ERNST,

*Appellant,*

*vs.*

A. G. CLEMENS, and H. G. McBRIDE, and A. G. CLEMENS,  
and H. G. McBRIDE, doing business as IDEAL MANU-  
FACTURING COMPANY,

*Appellee.*

---

## REPLY BRIEF FOR APPELLANT.

---

ALAN FRANKLIN,

356 South Spring Street, Los Angeles 13,

*Attorney for Appellant.*

J. CALVIN BROWN,

704 South Spring Street,

Los Angeles 14, California,

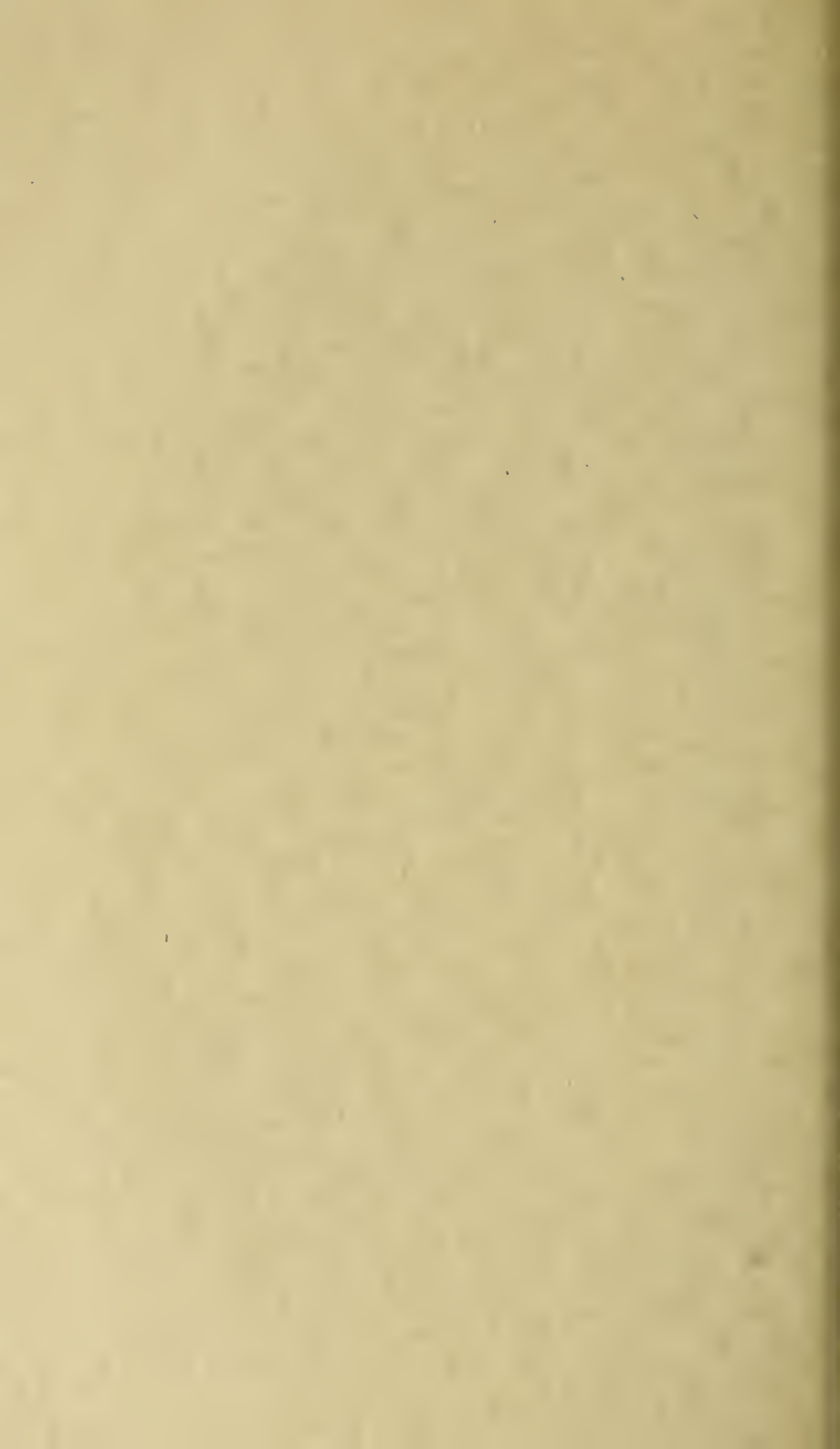
*Of Counsel.*

FILED

MAY 15 1950

PAUL P. O'BRIEN,

CLERK



## TOPICAL INDEX

	PAGE
Discussion of chronolgy of case.....	1
Interpretation of prior patents.....	3
Trial court's basic errors.....	5
Construction of Patent No. 2,288,159.....	6
Infringement only issue .....	10
Infringement of Patent No. 2,288,159.....	11
Construction of Patent No. Re 22,740.....	14
Infringement of Patent No. Re 22,740.....	16
Conclusion .....	22

## TABLE OF AUTHORITIES CITED

CASES	PAGE
Bankers Utilities Co. v. Pacific Nat'l Bank, 32 F. 2d 105.....	20
Bianchi v. Barili, 184 F. 2d 793.....	19
Eibel Process Company v. Minnesota and Ontario Paper Co., 261 U. S. 45, 43 S. Ct. 279.....	17
Engineering Development Lab. v. Radio Corp., 153 F. 2d 523....	20
Miller v. Eagle, 151 U. S. 186, 38 L. Ed. 121, 14 S. Ct. 310.....	14
Oates v. Camp, 83 F. 2d 111.....	20
Payne Furnace & Supply Co., Inc. v. Williams-Wallace Co., 117 F. 2d 823.....	4
Topliff v. Topliff, 145 U. S. 156, 36 L. Ed. 658.....	3

## TEXTBOOKS

Walker on Patents (Deller's Ed.), Secs 245-247, pp. 1209-1212 .....	17, 20
Walker on Patents (Deller's Ed.), Sec. 249, p. 1218.....	20
Walker on Patents (Deller's Ed.), Sec. 470, p. 1708.....	14

No. 12323

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

---

EARL A. ERNST,

*Appellant,*

*vs.*

A. G. CLEMENS, and H. G. McBRIDE, and A. G. CLEMENS,  
and H. G. McBRIDE, doing business as IDEAL MANU-  
FACTURING COMPANY,

*Appellee.*

---

## REPLY BRIEF FOR APPELLANT.

---

### Discussion of Chronology of Case.

It is interesting to note on pages 1 and 2 of the Brief for Appellees that counsel for appellees "do not find it feasible to correct inaccuracies or omissions in the discussion of the 'inventions in suit' contained in Appellant's Opening Brief (pp. 3-14)."

It would indeed not be feasible to correct any alleged inaccuracies or omissions contained in the discussion in Appellant's Opening Brief, page 3, under the heading "The Inventions in Suit," because there are no material inaccuracies or omissions in said discussion. Furthermore, said discussion of the inventions in suit in Appellant's Opening Brief is supported by Plaintiff's Exhibit 7, the photograph of the slow, but the fastest potato sacking machine in the industry, at the time Appellant and his de-

ceased brother came to Bakersfield in 1939 and invented their potato sacking machine, and said discussion is further supported by Appellant's patents in suit, by Appellant's potato sacking machines, Plaintiff's Exhibits 8, 9, and 10, and by the copying of the Appellant's inventions and infringement of his patents by the defendants-appellees.

The statement, on pages 1 and 2 of the Brief for Appellees, that appellee's chronology is supported generally by the "*uncontroverted*" testimony of J. Walker Glenn and Spencer Darby Day, is without legal significance, in view of the controlling fact that the testimony of said witnesses is "*uncorroborated*" by any documentary or any other evidence. The defendants' Exhibits A, B, C, D and E, referred to in the testimony of Spencer Darby Day, as machines of the Biloff or Sill type, are not prior art because the defendants did not start building said machines until 1946 [Tr. p. 107] after the patents in suit were issued or at least filed in the Patent Office. The F. J. Ernst patent No. 2,288,159 was filed Sept. 30, 1940 and the Ernst patent Re. 22,740 was filed originally on April 13, 1942. Appellant manufactured his machine covered by his patent No. 2,288,159 as early as 1940 [Tr. p. 91], and manufactured his automatic jigger covered by his patent Re. 22,740 as early as 1942 [Tr. p. 91], and since appellant's machines became very popular [Tr. p. 91] there is hardly any doubt that the defendants got their ideas for building their infringing machines, which appear in said Defendants' Exhibits A, B, C, D and E, from appellant's patented machines, Plaintiff's Exhibits 8, 9 and 10, rather than from the so-called Biloff or Sill machines. It is very significant that defendants have produced no documentary evidence illustrating the so-called Biloff and Sill machines

[Tr. pp. 107 and 109]. The witness Day only stated that the Defendants' Exhibits A, B, C, D and E were like the Biloff and Sill machines. It is also significant that Biloff could not obtain a patent in the potato-sacking art for his alleged machine, while the Ernst brothers did obtain patents in said art for their meritorious inventions (see Brief for Appellees p. 3).

### Interpretation of Prior Patents.

The statement on page 2 of the Brief for Appellees that appellees' chronology is in several instances supported by the testimony of Plaintiff-Appellant's expert witness, Harry Gearing, is without foundation. Mr. Gearing testified as a mechanical expert from the patents in suit and the prior art patents. As for the Bradbury Grain Separator patent No. 826,988, to which Mr. Gearing testified [Tr. pp. 282 and 283] the hypothetical construction of filling the perforations of the screen 72 to form a platform, assumed by counsel for defendants to anticipate appellant's platform, cannot be considered as an anticipation of anything in appellant's patents, since the filling of the screen perforations to make a platform is not suggested in the said Bradbury patent. The applicable rule is stated in *Topliff v. Topliff* and another, 145 U. S. 156, 36 L. Ed. 658, as follows:

"It is not sufficient, in order to constitute an anticipation of a patented invention, that the device relied upon, might, by modification, be made to accomplish the function performed by that invention, if it were not designed by its maker, nor adapted, nor actually used for the performance of such function."

The Bradbury patent No. 826,988 is considered in detail in Appellant's Opening Brief, pages 62-63, and shown



to lack the essential elements of appellant's invention, as covered by his patent in suit, No. Re. 22,740, and to operate on an entirely different principle from that of appellant's sack jigger included in his said patent. The Bradbury patent shows *no jigger board* or platform on which *sacks* may be supported and *held stationary to receive potatoes*, to be jiggled by the horizontal reciprocation of the jigger board for *settling and compacting the potatoes in said sacks*. This novel concept of appellant's invention is not shown in the Bradbury patent or any other patent of the prior art set up in the answer, and consequently said prior patents are entirely foreign to appellant's invention.

It may here be noted that all of the prior patents set up in the answer are in different arts from the *potato-sacking* art in which appellant's patents are included, in view of the fact that all of said patents state that the machines disclosed therein are used for handling products other than potatoes, and there is no evidence that any of said prior patents were ever built and successfully used for sacking potatoes or anything else. The prior art patents are nothing but *paper* patents. A prior patent in *one art* is not a valid reference against a patent in *another art*, which accomplishes a *new* and useful result, like appellant's inventions, and particularly when the new result is not even suggested in the prior patent. *Topliff v. Topliff, supra*. Appellant's counsel at the trial of this case objected to the prior art patents, on the grounds that they are definitely located in different arts from the potato-sacking art, in which the patents in suit are located, but the trial judge overruled counsel's said objection [Tr. pp. 103-104].

*Payne Furnace & Supply Co., Inc. v. Williams-Wallace Co.*, 117 F. 2d 823, 825 (C. C. A. 9).



### Trial Court's Basic Errors.

On page 4 of the Brief for Appellees, a statement from the trial court's decision [Tr. pp. 18-19] is quoted, as follows:

"In a situation like the present one, we are in between a veritable Scylla and Chrybdis. If we interpret the claims as they stand, there is no infringement. If, on the other hand, by resort to the specifications, we interpret them broadly and carry into the claims the elements which are not in them, we land the device in the prior art, and there is no invention."

The above statement is nothing more than a futile attempt, by flashy rhetoric, to read out of the record the controlling facts and the law of the case. Said statement ignores the *major* contribution of appellant's inventions to the potato-sacking industry and ignores the *doctrine of equivalents*; and as for the alleged landing the appellant's device in the *prior art*, if the claims of appellant's patents are interpreted broadly, as they should be, we ask: "What prior art?" Where in the prior art is found appellant's shiftable baffle plates or shearers 52, of his Patent No. 2,288,159, arranged to be gripped *directly* by the operator standing adjacent one of the sacks alongside the machine, and moved by the operator, directly by hand, longitudinally of the conveyor belt from one sack to another, for directing the potatoes from a side edge of the conveyor belt into said sacks for filling said sacks successively with potatoes, until all of the sacks, arranged alongside the outer side edge of the conveyor belt, are filled with potatoes? And where in the prior art is found appellant's jigger board or elongated platform 22 of patent Re. 22,740, for jiggling and compacting the potatoes in the sacks supported on said platform at one side of a belt conveyor?

In every claim of every patent there is disclosed a *novel and inventive concept* of the patented invention, which concept is embodied in a *new combination* of elements, the particular construction of which elements may vary in form or construction so long as they perform their respective functions. The lower court could see only the particular elements of the combination of the claims, of the patents in suit, but could not see the *novel concept and combination of elements* of appellant's inventions, despite the uncontroverted evidence of the *new and highly useful results* accomplished by appellant's inventions. The lower court could not see the forest for the trees.

### Construction of Patent No. 2,288,159.

Against appellant's patent in suit, No. 2,288,159, two prior patents were advanced as the appellees' best references, namely, Cunningham, No. 873,991, and Helenbolt No. 1,338,729 [Tr. p. 103]. Other prior patents were not advanced, because those advanced show the most. Said Cunningham and Helenbolt patents are carefully considered on pages 39-42 of Appellant's Opening Brief. It is clearly shown in said brief that neither of the machines of said two prior patents could be used for sacking potatoes. Moreover, said prior patents do not have the novel combination of elements of Claim 1 of appellant's patent in suit No. 2,288,159. And it is significant that neither of said patents, Cunningham nor Helenbolt, which counsel for defendants-appellees considered his best references, was cited against Claim 1 of said patent in suit, which is the claim sued on. Furthermore, no references or prior art were cited against said claim 1, which was claim 11 in the patent application.

In the Cunningham patent, No. 873,991, one of the appellees best references against appellant's patent No. 2,288,159, the wing-scraper blade 47 has to be *swung* on its pivot or shaft 44 by a slow, complicated mechanism, including a hand wheel 41, shaft 40, worm 42, worm gear 43 and pivot shaft 44, so that the straight rollers 36 and 37 and belt may be raised by a slow, complicated mechanism including a hand wheel 21, shaft 20, two gears 22 and 23, two racks 24 and 25 and arms 31 and 32, so that said rollers 36 and 37 may be moved over and past cone rollers 7 and 8 which are journaled in stationary uprights 2 supporting tracks 9 on which the Cunningham mechanism travels. All of the above complicated mechanism of said Cunningham patent is eliminated by appellant's simple and highly meritorious invention. The Cunningham machine was no doubt uppermost in the mind of plaintiff's expert, Harry Gearing when he stated that appellant's invention consisted in its very simplicity [Tr. p. 256]. The Cunningham patent does not disclose a baffle plate or shearer mounted to be moved along tracks *longitudinally* over a conveyor belt by the operator of the machine, from one sack to another for deflecting potatoes from said belt successively into sacks, as in appellant's sacking device covered by his patent in suit No. 2,288,159. Appellant's *potato sacking* device and the Cunningham unloading mechanism, patent No. 873,991, for handling *clay*, *coal* and other loose material, are entirely noncognate.

In the Helenbolt patent No. 1,338,729, appellees' other best reference against appellant's patent No. 2,288,159, the deflectors 28 do not *deflect potatoes into bags*, but deflect apples, oranges, and other fruit with tough skin onto screens for *grading* the same. If potatoes were deflected onto the screen in the Helenbolt *sorting apparatus* the deli-

cate skin of the potatoes would be bruised and scraped off and the potatoes would soon rot [Tr. pp. 58, 167 and 168]. The deflectors 28 in the Helenbolt apparatus are *not freely* mounted on tracks, so that they may be gripped *directly* by the operator of the machine at any point along the conveyor belt and moved directly by hand by the operator from one bag to another alongside said belt, as in appellant's invention covered by patent No. 2,288,159. In the Helenbolt apparatus the deflectors 28 are not gripped directly by the operator and moved by hand from one screen to another, but when it is desirable to move said deflectors from one position to another, it is necessary for the operator, if there were only one operator, to walk from the front of the apparatus around one end of the apparatus to the back of the same and turn cranks placed on the rear ends of the shafts 36 to rotate the pulleys 35 to draw the deflectors 28 along the conveyor belts 9 by means of the small belts or cables 33 and small idler pulleys 34, which belts are connected to said deflectors. (See Helenbolt patent No. 1,338,729, p. 1, second column, lines 103-110, and p. 2, first column, lines 1-37.) [Tr. pp. 166-167.] This Helenbolt machine is a *sorting* apparatus, not a *potato-sacking* machine like appellant's machine in suit. Most of the work of the Helenbolt machine is done by hand and it requires several men to operate it. Several men stand in front of the machine beside the barrels 19, and separate the culls, which are dropped into the chutes or funnels 20, while the desired grade of the fruit, such as apples, are put into the barrels 19 by hand. Another man stands in back of the machine and turns the cranks on the shafts 36 to move the deflectors 28 from one screen 16 to another. (See Helenbolt patent p. 1, first column, lines 12-28, and p. 2, lines 89-94, first column, lines 10-37.) [Tr. p.

168.] There is nothing in the Helenbolt patent that even suggests that it could be used for sacking potatoes, and the elements and construction of said machine definitely exclude the possibility of such use. Moreover, appellant's machine can be operated by *one* man only, and there is no suggestion in the Helenbolt patent that his machine could be operated by any less than two or three men at the front, and one man at the rear of the machine.

The patents to True, No. 1,369,502, Paisley, No. 1,818,427, and Vosler, No. 2,026,200, referred to on page 18 of Brief for Appellees are not included among the best references set up against Appellant's patent in suit No. 2,288,159 [Tr. p. 103]. The selected patents to Cunningham and Helenbolt have been considered in this brief. Said patents to True, Paisley and Vosler are not potato-sacking machines and offer no suggestion as to how they could be applied to such use.

Claim 1 of appellant's patent No. 2,288,159, specified "coupling means forming an acute angle with the sleeves so that the plate is positioned obliquely across the belt *for the purpose described.*" The "purpose described" appears in said patent on page 2, first column, in the paragraph in lines 19-30 as follows:

"One of the most important features of the invention will now be explained. Reference is made to the shiftable baffle plates or shearers 52 in the form of a panel having the *curved end* 53. One such shearer is provided for each passage just above the endless belts.  
\* \* \*

"\* \* \* *The curved portion of the shearer extends far enough toward the open mouth of the sack to avoid unnecessary loss or damage to the article being sacked.*"



The curved ends 53 of the shearers 52 appear in Fig. 3 of the drawing of appellant's patent in suit No. 2,288,159 and extend outwardly over the outer edges of the conveyor belts 18 and 19 to a point just above the inner edges of the open mouths of the sacks 12, whereby the potatoes are directed by the curved ends 53 of the shearers into the mouths of said sacks, and none of the potatoes are lost or damaged by being misdirected by the shearers 52 and dropped outside of the sacks. *The curved ends 53* of appellant's shearers 52 are not found in any of the prior art patents set up in the defendants' First Amended Answer [Tr. p. 5]. *Since there are no sacks supported alongside a belt conveyor* in any of the prior art patents there are necessarily *no curved ends of shearers* extending to the open mouths of sacks for guiding the potatoes from the conveyor belts into such sacks. The curved ends 53 of appellant's shearers are embodied in the shearers of the defendants-appellees' machines as shown in Defendants' Answers to Plaintiff's Interrogatories VII and IX, Exhibits 1 and 2 [Supplemental Transcript of Record pp. 573 and 574].

### Infringement Only Issue.

While the prior art patents selected [Tr. p. 103] as best references against patent in suit No. 2,288,159 are considered somewhat in detail in this brief, it is not necessary for appellant to show that the patents in suit are valid over the prior art, because said patents are *held valid* by the lower court [Tr. pp. 17, 31 and 32]. The patents in suit being held valid, the *only issue before* this Honorable Court is the *question of infringement* of claim 1 of each of said patents, and the *gross error* of the lower court in *narrowly construing* the patents in suit, *contrary*

*to law, and erroneously holding, contrary to the evidence, that the defendants-appellees' cheap-imitation machines do not infringe the claims in issue of the patents in suit.*

### **Infringement of Patent No. 2,288,159.**

Infringement, by defendants-appellees, of Claim 1 of appellant's patent in suit No. 2,288,159, is clearly shown in pages 23-33 of Appellant's Opening Brief, and also by the fact that the baffle plates or shearers of defendants-appellees' machines have the curved or bent ends 53 of the shearers 52 of appellant's said patent, as shown in Interrogatory Exhibits 1, 2 and the full view Exhibit 3 of Defendants' Answers to Plaintiff's Interrogatories. The curved or bent ends 53 of the baffle plates or shearers 52, shown in Fig. 3 of appellant's patent No. 2,288,159, are also shown clearly in *Plaintiff's* Exhibits 8 and 9, near the left end of the machine and in Plaintiff's Exhibit 11-B at the right end of the machine, and said *curved or bent ends* of the baffle plates or shearers of *appellees'* machine are shown in Defendants' Exhibits A, B, C and D. It will be noted that the baffle plates or shearers 52 in appellant's patent No. 2,288,159 extend obliquely across the conveyor belt to the *far side* of each sack 12 according to the direction of movement of the belt, and, to be operative, the ends of said baffle plates at said far side of the sacks are curved or bent backwardly to said far side of the sacks to make sure that the potatoes will be directed by the ends 53 of the baffle plate into the sacks; otherwise, if the plates were not bent and extended straightly obliquely of the belt to the far side of the sacks, many of the potatoes would be misdirected by the straight oblique plates over the far edges of the sacks and said potatoes would drop outside of the sacks and be lost or damaged. The state-



ment in Claim 1 of patent No. 2,288,159 that “the plate (52) is positioned obliquely across the belt for the *purpose described*” therefor, means that the baffle plates 52 are curved or bent at their ends 53 for the purpose of directing the potatoes from the conveyor belt into the sacks, and thereby preventing the straight oblique sides of the baffle plates 52 from misdirecting the potatoes outside of the sacks. Nowhere in the prior art is this curved or bent end 53 of appellant’s oblique baffle plate shown, but the defendants-appellees have copied it from appellant’s machines and have infringed Claim 1 of appellant’s patent No. 2,288,159, which specifies that the baffle plate (52) is positioned obliquely across the belt for the purpose described, or for the purpose of directing potatoes from the conveyor belt into sacks below a side edge of said belt.

An important test in determining the question of infringement of a patent, is *interchangeability* or noninterchangeability of *parts* of a patented machine and the parts of the alleged infringing machine. The appellant’s baffle plate or shearer 52 carried at its ends on *sleeves* and the appellees’ baffle plate or shearer carried at its ends on *trolleys*, are definitely interchangeable from the machines of one party to the machines of the other party.

Defendants’ answer to Plaintiff’s Interrogatory II states that in Form 1 of their machine the baffle plate is suspended from a *pair of rods* and that a *trolley* comprising a pair of sheaves mounted in a framework is arranged for rollable travel on each of the rods. From the framework vertically depends a suspension member, the lower end of which is bolted to the shear plate. The loose sleeves 54 and 55 on which appellant’s baffle plate or shearer 52 is mounted could be slipped on the *pair of rods* stated in De-

defendants' Answer to Plaintiff's Interrogatory II so that appellant's baffle plate could be made to slide along said rods of defendants' machine over a conveyor belt, while the appellees' trolleys on which their shear plate is mounted could be placed on the rods 56 and 57 of appellant's sacking device shown in his patent in suit No. 2,288,159.

In Defendants' Answer to Plaintiff's Interrogatory II, Form 2 of defendants' machine, it is stated that *one end* of defendants' shear plate is bolted to a suspension member of the framework of a trolley which rolls along a rod, while the *other end* of said shear plate is mounted on a sheave which rolls along the upper edge of a plate secured to the side of the machine opposite the side on which the single trolley rod is secured. This form of *appellees'* shear plate unit could be placed in appellant's sacking device with the trolley on one end of said shear plate resting upon one rod 56 and the sheave on the other end of said shear plate resting upon the other rod 57 of appellant's sacking device of patent No. 2,288,159, and appellees' shear plate could be moved along said rods in appellant's device like the loose sleeves 54 and 55 of appellant's baffle plate or shearer 52, while one sleeve on the outer end of *appellant's* baffle plate or shearer 52 could be slipped on the single rod at the outer side of *appellees'* Form 2 machine, and *appellant's* other sleeve, on the inner end of his baffle plate could be split in half longitudinally on a horizontal diametrical plane and the lower half of said sleeve removed, leaving the *under-grooved upper half* of the split sleeve on the inner end of the baffle plate or shearer 52, which upper half of said split sleeve would fit over the *upper edge of the plate* secured to the *inner* side of appellees' said Form 2 machine, shown in Plaintiff's Exhibit 11-B, and in Defendants' Exhibits A and C.

The interchangeability of the baffle plates or shearers in the machines of the parties to this suit, as above described, shows clearly that the *trolleys, or one trolley and a sheave* for supporting appellees' baffle plate or shearer are merely colorable *mechanical equivalents* of appellant's *loose sleeves* on which his baffle plate or shearer is mounted, and unmistakably establishes the fact that *defendants'-appellees' sacking machines infringe appellant's patent* in suit No. 2,288,159.

Interchangeability of parts as a test of infringement of a patent has been recognized by this Court in the case of *Bianchi v. Barili*, 184 F. 2d 793 (C. C. A. 9th Cir.).

See also:

Walker on Patents (Deller's Ed.), Sec. 470, p. 1708;

*Miller v. Eagle*, 151 U. S. 186, 38 L. Ed. 121, 14 S. Ct. 310.

### Construction of Patent No. Re. 22,740.

Three prior patents were selected at the trial by counsel for the defendants, as the best references of the defendants against the plaintiff's patent in suit, No. Re. 22,740, which prior patents are Bradbury, No. 826,988, Naeher, No. 1,719,124, and Erickson, No. 2,043,739. Other prior patents set up against said patent in suit in the First Amended Answer to Complaint, were not selected at the trial of the case. Neither the Bradbury nor the Naeher patent are file wrapper references, nor is the Erickson patent a file wrapper reference against the patent in suit No. Re. 22,740. The Erickson *et al.* patent No. 2,043,739 appears in Paragraph VIII of the First Amended Answer to Complaint [Tr. p. 7] as a file wrapper reference against

appellant's patent in suit No. 2,288,159. Said Erickson *et al.* patent is not advanced in the Brief for Appellees against appellant's patent No. 2,288,159, but is irregularly advanced against appellant's patent No. Re. 22,740 in said brief, page 26. The Erickson patent has nothing in common with either patent in suit, because it shows no mechanism for either sacking or jiggling potatoes.

The selected Bradbury patent is carefully considered on pages 62 and 63 of Appellant's Opening Brief, and is also considered in the first part of this Reply Brief for Appellant, under the heading "Discussion of Chronology of Case." It is shown that said Bradbury patent operates on an entirely different principle from that of Appellant's Sack Jigger covered by appellant's patent No. Re. 22,740, and that said Bradbury patent could not be used for sacking potatoes.

The Naehér patent No. 1,719,124 and the Erickson patent No. 2,043,739 are fully considered on pages 63, 64 and 65 of Appellant's Opening Brief. The Naehér patent and the Erickson patent both operate on different principles from those of appellant's patents in suit and are not capable of functioning to sack potatoes. The Naehér patent is for handling *grain*, not potatoes, and it has a *major vertical movement* and a minor horizontal movement. Said vertical movement in Naehér's machine would throw the potatoes up like a jumping bean [Tr. p. 163] and they would drop upon each other and become bruised [Tr. pp. 57, 58], while appellant's jigger board has a *major horizontal movement* which causes the potatoes to slip over each other and settle and pack in the sack without bruising each other. The lower court took judicial notice of this *novel* operation of appellant's invention

[Tr. p. 163]. The Erickson patent has no jigger board with *cleats* for holding sacks *stationary* thereon against longitudinal displacement, while said sacks are being filled with *potatoes*. The Erickson patent is for mixing and proportioning fruit and the product comes out of the apparatus in *liquid* form and not in the form of *bags filled with potatoes* as in appellant's machine.

From the foregoing analysis of the best references advanced against claim 1 of appellant's patent in suit, No. Re. 22,740, it should be obvious that there is no suggestion in any of said references of appellant's invention covered by said claim of said patent, nor any element in said references that could narrow the scope of said claim of appellant's said patent, to prevent reading of said claim on the colorable equivalents of the appellees' infringing potato-sacking devices or machines, as embodied in Exhibit 3-3 of Plaintiff's Interrogatories, and admitted in Defendants' Answer to Plaintiff's Interrogatory XI, and as shown in Plaintiff's Exhibits 11-A, 11-C, 12-A, and 12-B, and in Defendants' Exhibits A, B, C, D and E.

### Infringement of Patent No. Re. 22,740.

Infringement of claim 1 of appellant's patent No. Re. 22,740 is clearly set forth on pages 46-58 of Appellant's Opening Brief, and more particularly element by element on pages 47 to 53 of said brief. There is no question that claim 1 of said patent in suit reads directly on the accused machines and devices of the defendants-appellees.

Counsel for appellees in his Brief for Appellees assert with emphasis that the question of infringement is a question of *fact* and should not be disturbed unless clearly erroneous, and counsel for appellant with no less emphasis asserts that before determining the *fact* of infringement



the court first looks into art and determines whether the invention has made a substantial contribution to the art and construes the patent, either broadly or narrowly, according to the state of the art and according to the *laws* of construction of patents to determine exactly what invention is covered by the claims of the patent. The *construction* of a patent is a question of *law* which must be determined before attempting to read a patent claim on an accused machine. Appellees' counsel would have this Honorable Court apply the issue claims of the patents in suit to appellees' accused machines, like the lower court did, without first construing said claims in the light of the *shortcomings* of the prior art and in the light of the *major contribution* made by the patents in suit to the potato sacking industry [Tr. p. 55], in order to determine the scope of appellant's claims to which he is lawfully entitled.

"In administering the patent law the court first looks into the art, to find what the *real merit* of the alleged discovery or invention is, and whether it has advanced the art substantially. If it has done so, then *the court is liberal in its construction of the patent, to secure to the inventor the reward he deserves.*" *Eibel Process Company v. Minnesota and Ontario Paper Co.*, 261 U. S. 45, 63, 43 S. Ct. 279, 79 L. Ed.

Walker on Patents (Deller's Ed.), Vol. II, pages 1209-1212, Secs. 245-247.

On page 9 of Brief for Appellees appears the following statement of a rule of the Supreme Court:

"The rule requires that an Appellate Court make allowance for the advantages possessed by the Trial Court in appraising the significance of conflicting testimony and reverses only 'clearly erroneous' findings."

The above-stated rule does not apply to this Honorable Court in considering the testimony of plaintiff-appellant's patent expert Harry Gearing [Tr. pp. 202-297] whose deposition was taken in Los Angeles, California, before the trial at Fresno, California, and said deposition began on February 28, 1949, before Paul Lehnhardt, Jr., a Notary Public, and not before the District Judge, who was not present. The trial judge therefore, has no advantages over this Honorable Court in appraising the testimony of said expert witness, Harry Gearing, and this Court is not bound by any misconstruction of said witnesses' testimony either by the trial judge or counsel for appellee.

On page 14 of Brief for Appellees it is asserted without justification that the Ernst conveyor belt unloading device was at most a very *minor* contribution to a *crowded* and well developed field of endeavor. To said assertion we unqualifiedly demure. The patents set up in the First Amended Answer are in a *different art* from that of the potato sacking art and have no probative value in narrowing the scope of the claims of the patents in suit. The nearest approach to prior art is the slow machine, Plaintiff's Exhibit No. 7, which had no jigger board and could sack only 150 sacks of potatoes an hour [Tr. p. 87]. The plaintiff's expert witness, Gearing, did not say that the appellant's invention were in a *crowded* art and the defendants' witness, J. Walker Glenn, did not qualify as a patent expert [Tr. p. 103] and he testified that he had never seen the plaintiff Ernst's machine [Tr. p. 160].

Counsel for appellees advert to the file wrappers of the patents in suit, which file wrappers were not plead in the First Amended Answer. However, said file wrappers are



of no probative value in view of the fact that appellant's patents made a *major* contribution to the potato sacking art and are entitled to a liberal construction, and if, for the sake of argument only, said patents were given the narrowest construction possible they would still be broad enough to be entitled to equivalents such as the mere colorable equivalents of the defendants'-appellees' infringing machines, in which the accused baffle plates or shearers of the appellees, are interchangeable with the appellant's baffle plates or shearers, and in which the appellees' jigger mechanism for the jigger board perform the same function in substantially the same way as the *appellant's* jigger board reciprocating mechanism, the only *immaterial* difference being that in the accused machine of appellees the jigger board operating mechanism is placed at an *end* open locus and connected to one *end* of the jigger board instead of at a *central* open locus and connected to the *central* part of the jigger board as in appellant's machine, without change of function, mode of operation or result of the appellant's jigger board operating mechanism. Appellees' jigger board mechanism is nothing but a transposition of parts which does not avoid infringement.

*Bianchi v. Barili*, 184 F. 2d 793 (C. C. A. 9).

"It may be remarked that courts generally have been disposed to give much consideration to the fact that an applicant for practical reasons of expediency is often compelled to unduly narrow his claims while the application is pending, and in such cases *lean as far as possible in the direction of liberality* where the limitations imposed by the Patent Office appear to have been unwarranted. It may be noted that the

Court of Appeals of the Second Circuit *gives effect to limitations imposed by the Patent Office only in so far as an estoppel has been created.* Westinghouse Elec. Mfg. Co. v. Condit Elec. Mfg. Co., 194 Fed. 427 (C. C. A. 2),” and other cases cited.

Walker on Patents (Deller’s Ed.), Vol. II, Sec. 249, p. 1218.

“Any patent has some range of equivalents.”

Walker on Patents (Deller’s Ed.), Vol. II, pages 1209-1212, Secs. 245-247.

*Eng. Development Lab. v. Radio Corp.*, 153 F. 2d 523 (C. C. A. 2) (1946);

*Bankers Utilities Co. v. Pacific Nat’l Bank*, 32 F. 2d 105, 107 (C. C. A. 9).

This case is on all fours with the case of *Oates v. Camp*, 83 F. 2d 111, which held:

“There can be no question but that claim 10 of the patent reads on this device. Defendant’s contention that the claim must be limited to the exact device disclosed by the specification and drawings cannot be sustained. As said by the Supreme Court in *Smith v. Snow*, 294 U. S. 1, 11, 55 S. Ct. 279, 283, 79 L. Ed. 721, these ‘show a way of using the inventor’s method, and that he conceived that particular way described was the best one. But he is not confined to that particular mode of use, since the claims of the patent, not its specifications, measure the invention.’ ”

\* \* \* \* \*

“We find nothing in the prior art to render claim 10 invalid; and, while we agree that it is to be interpreted in the light of the specification and drawings, we think, as thus interpreted, it is broad enough to cover any road guard such as that of defendant comprising a sheet band maintained under longitudinal tension and attached to supports by means of offset springs so as to make use of the principle embodied in the patent.”

\* \* \* \* \*

“And when the character of the invention is considered, it is clear that there is infringement of the other claims of the patent relied on, as well as of claim 10. We cannot agree with him or his experts that the patent is one for a mere improvement in a crowded art. \* \* \* A study of these (prior) patents shows conclusively what is otherwise established by the evidence, *i. e.*, that prior to the invention of complainant, repeated efforts had been made to construct a satisfactory road guard but without success. Whether complainant’s invention be termed a pioneer or not, it unquestionably solved a problem for the solution of which others had sought in vain and made a substantial contribution to the safety of those who travel the highways. In such case, the law is well settled that he is entitled to a liberal construction of his claims and a liberal application of the doctrine of equivalents, to the end that he may not be deprived of the fruits of what he has done.”

### Conclusion.

It is submitted that the judgment of the lower court should be reversed as to the question of infringement and that appellees' accused machines be held to infringe the patents in suit, and that appellant is entitled to his costs and such other and further relief as may be considered proper by this Honorable Court.

Respectfully submitted,

ALAN FRANKLIN,

*Attorney for Appellant.*

J. CALVIN BROWN,

*Of Counsel.*